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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/774,762 Confirmation No.: 5562
Applicant : Kent Carlyle St. Vrain
Filed : January 31, 2001
Title : A SYSTEM AND METHOD FOR ORDERING
: CUSTOMIZED IDENTIFICATION DOCUMENTS
: VIA A NETWORK
TC/A.U. : 2621
Examiner : John M. Winter

Docket No. : 8426
Customer No.: 20349

Mail Stop Appeal Brief-Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

RESPONSE TO NOTIFICATION OF NON-COMPLIANT
APPEAL BRIEF (37 CFR 41.37)

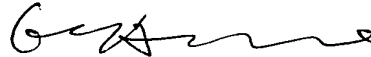
Sir:

On August 3, 2005 a Notification of Non-Compliant Appeal Brief was mailed in the above-identified application. The Notification stated that the Appeal Brief filed previously by applicant is defective for failure to comply with one or more provisions of 37 CFR 41.37. Two items required by 37 CFR 41.37 were specifically identified as not being included in the Brief, namely an Evidence Appendix and a Related Proceedings Appendix.

Enclosed herewith, in triplicate, is an Amended Appeal Brief containing an Evidence Appendix and a Related Proceedings Appendix.

The Amended Appeal Brief complies with all the requirements of 37 CFR 41.37.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: August 10, 2005



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AMENDED APPEAL BRIEF

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Sir:

This is an Amended Appeal Brief in the appeal from the final rejection of claims 11 - 14 of the application as set forth in the Office Action, made final, mailed June 21, 2004.

REAL PARTY IN INTEREST

The real party in interest in this appeal is Polaroid Corporation, a corporation organized and existing under the laws of the State of Delaware, of 1265 Main Street, Waltham, MA 02451.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF CLAIMS

Claims 11 - 14 have been rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

Claims 1 - 10 have been allowed.

STATUS OF AMENDMENTS

An Amendment in response to the Final Rejection was filed by appellant. Appellant proposed to amend claims 11 - 14 to even more particularly point out and distinctly claim the method recited therein.

In an Advisory Action the examiner indicated that the proposed amendments to claims 11 - 14 would not be entered because "they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal". In support of this conclusion the examiner stated that

[A]mending the preamble of claim 11 is insufficient to overcome the 35 USC 101 rejection because there is not a substantial interrelationship between the preamble and the body of the claim.

SUMMARY OF INVENTION

The invention of appellant which is recited in claims 11 - 14 is a method for a user to order customized identification documents over a network. The claimed method includes a number of method steps which are carried out over a network which, as is described in the specification, includes a user interface connected to the network, with the user interface being configured to provide communication between the user and a server coupled to the network. See, for example, page 2, lines 21 - 24.

The method steps may be carried out by means of various modules which can be coupled to the server by various networks including an Internet network connection, an Intranet network connection and a dial-up modem connection. See, for example, page 3 lines 23 - 27.

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The method includes a number of steps including creating at least one facsimile of an identification document, and providing the facsimile to the user (see page 5, lines 26 - 28. These steps, taken together and in the context of the method described in the application, clearly involve the creation of a document and sending, or transmitting, the document to a user by electronic means.

ISSUE

The sole issue in this appeal is whether the method recited in claims 11 - 14, is drawn to statutory subject matter.

GROUPING OF CLAIMS

Pursuant to 37 CFR 1.192(c)(7), appellant requests that claims 11 - 14 be considered together as a single group.

ARGUMENT

Summary

The method recited in claims 11 - 14 is carried out with the aid of technology and complies with the requirements for patentability established by 35 U.S.C. § 101.

Detailed Argument

I. The claimed method is carried out with the aid of technology.

In support of the rejection the examiner, in reference to the method recited in claim 11, has stated:

[T]his process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts.

This statement is at odds with the facts of record.

Claim 11 recites a method for a user to order customized identification documents over a network. The network, as described in the specification, may be the Internet. See, for example, page 1, lines 9 - 11 and page 5, lines 19 -20. It is beyond dispute that the Internet is within the technological arts.

Although the phrase "over the network" appears in the preamble of the claim, nevertheless that phrase gives meaning to, and is an integral part of, the claimed method. The specification teaches that various networks can be used including an Internet network connection, an Intranet network connection and a dial-up modem connection. The language present in patent claims must be interpreted in the context of the supporting disclosure in the specification.

In addition, the claimed method includes a number of method steps which can lead to the delivery of an

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identification document to a user, including the steps
of

creating at least one facsimile of
of an identification document...

and

providing said at least one facsimile
to the user

These method steps must be interpreted in accordance
with the context of the method in which they are
recited.

Webster's New Collegiate Dictionary", G. & C.
Merriam, Co., Springfield, MA. ©1980 defines "facsimile"
as "an exact copy" and as "the transmission of graphic
matter (as printing or still pictures) by wire or radio
and its reproduction." Thus, the method steps of
creating a facsimile of an identification document and
providing the facsimile to a user, when interpreted in
the context of the claimed method and with the terms
being given their commonly-accepted and well understood
meaning in this context, involve the creation of an
identification document and transmitting it to a user by
electronic means. The use of technology is clearly
involved.

II. The claimed method produces a concrete, tangible and
useful result.

In support of the rejection, the examiner has cited
in *In re Musgrave*, 431 F. 2d 882, 167 USPQ 280 (CCPA
1970) and *AT&T v Excel Communications, Inc.*, 172 F3d at

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1358, 50 USPQ 2d at 1452. These opinions in fact support the conclusion that the method recited in claims 11 - 14 complies with 35 U.S.C. § 101.

The Court, in *Musgrave* stated

[A]ll that is necessary to make a sequence of operational steps in a statutory process within 35 U.S.C. 101 is that it be in the technological arts...

The claimed method of appellant does recite a sequence of operational steps which, as discussed above, is within the technological arts.

The Court, in *AT&T v Excel Communications, Inc.*, stated

[A] claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result, i.e., when the method recites a step or act of producing something that is concrete, tangible and useful.

Here, the claimed method satisfies this requirement for patentability. The method creates and delivers a customized identification document to a user.

III. The claimed method is not within any judicially created exception excluding certain subject matter as being patentable subject matter.

The examiner has stated that "...claim 11 only recites an abstract idea". Appellant submits that this statement is without any basis in the record. As has

been shown above, the claimed method produces a result which is concrete, tangible and useful,

The examiner has also asserted that "...all of the recited steps can be performed in the mind of the user or by use of a pencil and paper". Again, this statement is without any basis in the facts of record.

It is apparent that the method steps such as creating a facsimile and providing the facsimile to a user can not be performed in the mind of a person. Further, such method steps can not be performed by using a pencil and paper.

The claims are not drawn to any law of nature, natural phenomenon or abstract idea, or any category of subject matter which has been judicially determined to be excluded from subject matter which is patentable under Section 101.

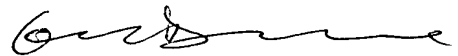
In summary, the method recited in claims 11 - 14 falls within the "process" category of the four enumerated categories of patentable subject matter in Section 101. The method produces a concrete, tangible and useful result, is carried out with the use of technology and is not within any judicially-created exception to the statutory categories of Section 101.

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CONCLUSION

For all the foregoing reasons, the rejections of claims 11 - 14 under 35 USC 101 should be reversed and all the claims in the application allowed.

Respectfully submitted,



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CLAIMS APPENDIX

Claims On Appeal

11. A method for a user to order customized identification documents over a network comprising the steps of:

providing the user with a plurality of badge design guidance data;

receiving a plurality of design badge data from the user;

storing said plurality of design badge data; prompting the user to provide at least one demographic data to be incorporated into said identification document;

receiving said at least one demographic data to be incorporated into said identification document prompting the user to provide at least one graphical representation corresponding to said at least one demographic data to be incorporated into said identification document;

receiving at least one graphical representation corresponding to said at least one demographic data to be incorporated into said identification document;

securely storing said at least one demographic data and corresponding at least one graphical representation;

creating at least one facsimile of an identification document incorporating said plurality of

design badge data and including said at least one demographic data and corresponding at least one graphical representation;

providing said at least one facsimile to the user;

prompting the user to approve or not approve the facsimile;

receiving the approval or not approval from the user;

if approval is received and then no payment data is stored then prompt the user for payment and location information, otherwise retrieve stored payment data including said location information;

if approval is received and no payment data is stored then receive said payment and location information;

if approval is received then verify that said location information is a legitimate organization;

if approval is received then verify using said payment information that a payment has been received;

if approval is received and the location information is verified, and if a verified payment has been received then manufacture said at least one identification document corresponding to the approved at least one facsimile;

deliver to said location said at least one identification document to the user.

12. The method as in claim 11, further comprising the steps of:

providing the user with a user id and
password;
prompting the user to provide at least one
user data;
receiving said at least one user data; and
securely storing said at least one user data.

13. The method of claim 11, wherein the step
of verifying that said location is a legitimate
organization includes:

retrieving said location information;
cross checking said location information with a database
of known legitimate organizations.

14. The method of claim 11, further
comprising the steps of:

providing the user with a plurality of
security feature design guidance data;
receiving from the user a plurality of
security feature design data;
securely storing said security feature design
data in a security feature design data database.

Claims Allowed

1. A system for generating and ordering an identification document over a network, the system comprising:

a user interface connected to the network in communication with a server also coupled to the network;

a data gathering module coupled to said server, said data gathering module capable of prompting a user to provide at least one demographic data and a corresponding graphical representation and receiving and securely storing said at least one demographic data and said corresponding graphical representation in a user demographic and picture data database coupled to said server;

an identification document design module coupled to said server, said design module capable of providing identification document design guidance data to said user and thereby prompting said user to provide identification document design data, the design module capable of receiving and securely storing identification document design data in a document design data base coupled to said server;

a payment module coupled to said server, said payment module capable of prompting the user to provide payment data and receiving and securely storing said payment data in said user database, said payment data including user location data and user payment data, said payment data being utilized to verify that a payment for

said identification document has been made and to provide a paid-in-full signal upon said verification;

a user verification module coupled to said server, said user verification module capable of retrieving said user location data, authenticating the identity of said user, and providing a user verification signal upon successful user authentication;

a service bureau coupled to said server and responsive to said paid-in-full signal, whereby in response to said paid-in-full signal and said user verification signal, said service bureau retrieves from said user data base said at least one demographic data and said corresponding graphical representation and retrieves from said document design data base said identification document design data, and produces a draft identification document incorporating said at least one demographic data and said corresponding graphical representation and said identification document design data;

a user approval module coupled to said server, said user approval module capable of providing a facsimile of said draft identification document to the user over said server through said network, and prompting the user to provide a job-acceptance signal;

said service bureau providing a final identification document to said user in response to said job-acceptance signal, said final identification document being the equivalent of an approved said draft identification document.

2. The system as in claim 1, wherein said data gathering module, said identification document design module, said payment module, said service bureau, said user approval module and said user verification module, can be coupled to said server by one of the following group consisting of an Internet network connection, an intranet network connection, a dial-up modem connection, and further wherein each module includes a plurality of computer processor instructions that can be executed by a computer processor located within said server and at least one processor remote from said server, wherein said computer processor instructions can be compiled instructions written in one of the group of computer languages consisting of C, C++, and Java and can be interpreted instructions written in one of the following group of computer languages consisting of visual basic, Java script, CGI script.

3. The system as in claim 1, wherein said at least one demographic data includes: the name of an employee, the name of a company, the employee number, the address of a company, the telephone number of a company, a security clearance level.

4. The system as in claim 1, wherein said corresponding graphical representation can include a digitally encoded picture, and a digitally encoded fingerprint.

5. The system as in claim 1, wherein said securely storing said at least one demographic data and said corresponding graphical representation includes encrypting said at least one demographic data and said corresponding graphical representation using a password to generate a plurality of password encrypted data.

6. The system as in claim 1, wherein said identification document design guidance data includes: a plurality of identification document orientation data including portrait and landscape orientations; a plurality of location data for placement of said graphical representation; a plurality of location data, orientation data, font type data, font size data for placement of said at least one demographic data on said identification document; a plurality of special printable indicia of security clearance level data; and a plurality of data for printing on both sides of said identification document.

7. The system as in claim 1, wherein said payment data includes: a shipping address; credit card information necessary to effectuate a credit purchase; debit card information necessary to effectuate a debit purchase; electronic transfer authorization information necessary to effectuate a credit purchase; and a purchase order number.

8. The system as in claim 1, wherein said user verification module includes a database containing a

plurality of business addresses and corresponding telephone numbers, wherein said location of the user is cross-checked with said business address and telephone numbers in said data base.

9. The system as in claim 1, further comprising:

a security feature design module configured and arranged to provide the user with security feature design guidance data and to prompt the user to provide security feature design data, said security feature design wizard securely storing said security feature design data in a user security feature database wherein said security feature design guidance data includes data directed to: an encoded magnetic stripe; a one-dimensional bar code; a two-dimensional bar code; micro-printing one or more characters; one or more UV visible security features printed on said document; and to securely store said security feature design data in a password encrypted file.

10. The system as in claim 1, further comprising a user registration module coupled to said server configured and arranged to query the user to provide at least one user data, and configured and arranged to receive said at least one user data and to securely store said at least one user data; wherein said at least one user data includes: a name of the user; a name of a company associated with the user; a location of said company associated with the user; a telephone number

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associated with the user; an e-mail address associated with the user.

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EVIDENCE APPENDIX

Applicant has not submitted in the application any evidence pursuant to §§ 1.130, 1.131 and 1.132 of 37 Code of Federal Regulations.

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RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a court or the Board of Patent Appeals and Interferences in any related proceeding.


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